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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,264	12/19/2005	Veronique Ferrari	05725.1420.0000	2132
22852	7590	04/01/2009		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER LOVE, TREVOR M	
			ART UNIT	PAPER NUMBER
			1611	
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			04/01/2009 PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/529,264

**Applicant(s)**

FERRARI ET AL.

**Examiner**

TREVOR M. LOVE

**Art Unit**

1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-66 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Acknowledgement is made to Applicant's most recent IDS filed 12/20/2007.

Claims 1-66 are pending and are currently under consideration with regard to Election/Restriction.

#### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1 and 3-56, drawn to a cosmetic composition comprising a styrene-free film-forming linear block ethylenic polymer.

Group II, claim(s) 2-56, drawn to a cosmetic composition comprising a non-elastomeric film-forming linear block ethylenic polymer.

Group III, claim(s) 57-63, drawn to an assembly comprising either the composition of group I or II.

Group IV, claim(s) 64, drawn to a process for caring for keratin materials by the application of the composition of either group I or II.

Group V, claim(s) 65, drawn to a use of the composition of groups I and II for the purpose of having the composition of groups I and II applied to the skin or lips.

Group VI, claim(s) 66, drawn to a use of a styrene-free and/or non-elastomeric film-forming linear block ethylenic polymer in a cosmetic composition in order to arrive at the composition being applied to the skin or lips.

Please note: Groups V and VI are drawn to non-statutory subject matter. The claimed inventions do not fall within at least one of the four categories of patent eligible

subject matter recited in 35 U.S.C. 101 (process, machine, manufacture, or composition of matter). For the purposes of restriction, the Examiner is interpreting the "use claim" as a "process of preparing a composition". The Examiner respectfully requests appropriate corrective action.

The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The common technical feature linking the claims is a film-forming linear block ethylenic polymer. This element cannot be a special technical feature under PCT Rule 13.2 because the element is shown in the prior art.

In the present case, Anton et al. (US Patent 6,153,206) (IDS reference) teach a film-forming linear block ethylenic polymer (see column 2, lines 55-59, and claim 1) like that of the instant technical feature. As a result, no special technical features exist among the different groups because the inventions in Groups I-VI fail to make a contribution over the prior art. In conclusion, Groups I-VI are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept, and therefore, restriction for examination purposes as indicated is proper.

**Species Election if any of Groups I-V is elected**

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

The special technical feature linking the genera is the glass transition temperature for the polymer, additional monomers, and the volatile and non-volatile oils. These elements cannot be a special technical features under PCT Rule 13.2 because the element is shown in the prior art.

The species are as follows:

**Species of glass transition temperatures.**

In the present case, Anton et al. (US Patent 6,153,206) (IDS reference) teaches glass transition temperatures for the block polymer, specifically -10 to 75°C and 76 to 120°C, which shows that at least a T<sub>g</sub> of greater than 40°C does not make a contribution over the prior art (see claim 4). As a result, no special technical feature exists among the claims because the inventions fail to make a contribution over the prior art.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. For example, from claim 10 Applicant may elect "a" which claims a glass transition temperature of greater than 40°C, "b" which claims a glass transition temperature of between 20-40°C,

OR "c" which claims a glass transition temperature of less than 20°C, the election is required for both the first and second blocks. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The following claim(s) are generic: claims 1 and 2.

**Species of the presence or absence of the additional monomer.**

In the present case, Anton et al. (US Patent 6,153,206) (IDS reference) teaches the A monomers can comprise mixtures of monomers, which include additional monomers such as ethylhexylmethacrylate, which shows that at least the methacrylate monomer does not make a contribution over the prior art (see claim 9). As a result, no special technical feature exists among the claims because the inventions fail to make a contribution over the prior art.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. For example, Applicant may elect the presence of the additional monomer, wherein election of said

specific monomer is required, or Applicant may elect the absence of the monomer. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The following claim(s) are generic: claim 33.

**Species of the presence or absence of the volatile oil.**

In the present case, Anton et al. (US Patent 6,153,206) (IDS reference) teaches the addition of volatile oil, specifically Anton teaches the volatile oil can be isododecane (see column 6, line 66), which show that at least isododecane does not make a contribution over the prior art. As a result, no special technical feature exists among the claims because the inventions fail to make a contribution over the prior art.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. For example, Applicant may elect the presence of the volatile oil, wherein election of said specific volatile oil is required, or Applicant may elect the absence of the volatile oil. The reply must also identify the claims readable on the elected species, including any claims

subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The following claim(s) are generic: claim 45.

**Species of the presence or absence of the non-volatile oil.**

In the present case, Anton et al. (US Patent 6,153,206) (IDS reference) teaches the addition of non-volatile oils, specifically Anton teaches the non-volatile oil can be a non-volatile hydrocarbon (see column 7, line 43), which show that at least the non-volatile hydrocarbons do not make a contribution over the prior art. As a result, no special technical feature exists among the claims because the inventions fail to make a contribution over the prior art.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. For example, Applicant may elect the presence of the non-volatile oil, wherein election of said specific non-volatile oil is required, or Applicant may elect the absence of the non-volatile oil. The reply must also identify the claims readable on the elected species, including any



claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The following claim(s) are generic: claim 48.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TREVOR M. LOVE whose telephone number is

(571)270-5259. The examiner can normally be reached on Monday-Thursday 7:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TL

/Sharmila Gollamudi Landau/  
Supervisory Patent Examiner, Art Unit 1611